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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,104	02/26/2004	Yasutaka Ishii	3273-0185P	4256

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EXAMINER

PUTTLITZ, KARL J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,104

Applicant(s)

ISHII ET AL.

Examiner

Karl J. Puttlitz

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/17/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In connection with the Notice of Withdrawal from Issue dated 10/17/2005, the following new grounds of rejection are now entered:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 5-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to the claimed "organic group", the claims lack sufficient written description within the meaning of section 112, first paragraph.

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention"); *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989)

("the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed").

Courts have stated that "[i]n claims involving [non-genetic] chemical materials, generic formulae *usually indicate with specificity what the generic claims encompass*. One skilled in the art can distinguish such a formula from others and *can identify many of the species* that the claims encompass. Accordingly, such a formula is normally an adequate description of the claimed genus." *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1568 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998). (emphasis added).

There is no such specificity here, nor could one skilled in the art identify any particular organic compound encompassed by the claims. Specifically, the written description does no more than describe the desired function of the compound called for, that is, it does not clearly set forth the structure of the desired organic group. The term organic group contains almost no information by which a person of ordinary skill in the art would understand that the inventors possessed the claimed invention. At best, it simply indicates that one should test an infinite number of compounds.

Claims 1 and 5-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for those structures listed in the specification does not reasonably provide enablement for all "organic groups" as recited in the rejected claims. The specification does not enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984)." See M.P.E.P. § 2164.

In the instant case the claims cover formulas (1) (2) and (3), which all have groups which are defined as an "organic group", see claim 1, for example. Based on the above standards, the disclosure must contained sufficient information to enable one

skilled in the pertinent art to use this invention without undue experimentation. See M.P.E.P. 2164.01. Given the scope of the claims, it does not.

The specification and the examples do not provide sufficient disclosure that would provide one of ordinary skill guidance to practice the invention, given the infinite amount of possible permutations of the claimed organic groups. In this regard, the disclosure does teach those of ordinary skill how to select appropriate organic groups, where the instant specification only describes specific organic groups. M.P.E.P. § 2164.06(b) citing "In *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991), [where the court pointed to a] "limited disclosure by appellants of ...particular cyanobacterial genera operative in the claimed invention...." The claims at issue were not limited to any particular genus or species of cyanobacteria and the specification mentioned nine genera and the working examples employed one species of cyanobacteria."

The examiner understands that there is no requirement that the specification disclose every possible embodiment if there is sufficient guidance given by knowledge in the art (See M.P.E.P. § 2164.05(a) "[t]he specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).").

However, the instant case goes beyond what is known in the art, because the specification does not offer any guidance on how one of ordinary skill would go about practicing the invention for recovery of every claimed organic group.

Applicant is reminded of the heightened enablement for chemical inventions. Specifically, the amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. [I]n the field of chemistry generally, there may be times when the well-known unpredictability of chemical reactions will alone be enough to create a reasonable doubt as to the accuracy of a particular broad statement put forward as enabling support for a claim. This will especially be the case where the statement is, on its face, contrary to generally accepted scientific principles. Most often, additional factors, such as the teachings in pertinent references, will be available to substantiate any doubts that the asserted scope of objective enablement is in fact commensurate with the scope of protection sought and to support any demands based thereon for proof. [Footnote omitted.]

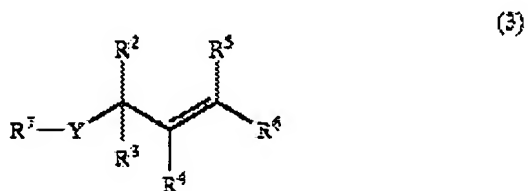
Here, the requirement for enablement is not met since the claims go far beyond the enabling disclosure. Base on the forgoing, therefore, claims 1 and 5-7 are *prima facie*, non-enabled for their full scope.

Claim Rejections - 35 USC § 102

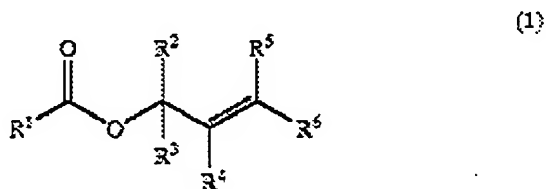
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 4, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 2004013076 (WO 076).

Claim 1 is drawn to a process for producing an allyl-containing compound represented by following Formula (3):



the process comprising the step of reacting an allyl ester compound represented by following Formula (1):



with a compound represented by following Formula (2):



in the presence of a catalytic amount of an iridium compound.

Claim 4 covers those embodiments of claim 1 wherein the compound represented by Formula (2) is one selected from the group consisting of alcohols, phenols, thiol compounds, carboxylic acids and thiocarboxylic acids.

Claims 5 and 6 cover those embodiments wherein the iridium compound is an organic iridium complex, and specifically a cationic iridium complex.

WO 076 teaches, in example 10, that phenyl allyl ether was prepared from phenol and allyl acetate using a homogeneous iridium catalyst. Specifically, a solution of phenol, $(Ir(COD)_2)^+ BF_4^-$ and allyl acetate was reacted and analysis showed that the conversion to phenyl allyl ether is 29 percent. The foregoing anticipates the rejected claims within the meaning of section 102.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 076.

Claim 7 is drawn to specific iridium complexes. WO 076 fails to specifically mention the specific iridium complexes recited in the claim. However, WO 076 teaches complexes such as CpRuCl (dppe). Those of ordinary skill would be motivated to substitute iridium for Ru in the disclosed complexes since WO 076 particularly states that iridium is a preferred metal in the catalyst complexes, see page 25 (top). Accordingly, the recited iridium complexes are within the motivation of those of ordinary skill, and therefore, prima facie obvious.

Conclusion

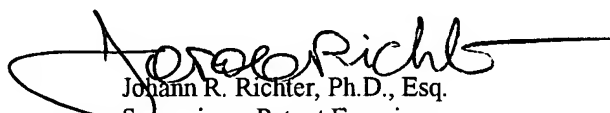
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at telephone number (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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